

5 **REMARKS****Paragraph 2 of the Office Action**

Claim 16 is rejected under 35 USC §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant
10 regards as the invention.

Claim 16 has been amended in accordance with the Examiner's statement.

Withdrawal of the rejection is respectfully requested by the applicant.

Paragraphs 4-12 of the Office Action

15 Claims 1, 18 and 19 are rejected under 35 USC §102(b) as being anticipated by Berlin. Claims 2-10 are rejected under U.S.C. §103(a) as being unpatentable over Berlin as applied to claim 1 above. Claims 11-17, 20 and 21 are rejected under U.S.C. §103(a) as being unpatentable over Berlin as applied to claims 1, 2, 6 and 9-11 and further view of May.

20 Applicant's amended claims 1, 15 and 18 include the limitation of a panel that is between 1 inch and 2 inches wide. The width, or the lack thereof, is important to applicant's device for two reasons. The first is that since applicant's device is adapted for dispensing tissue paper, a relatively inexpensive product, it is important that applicant's device likewise be inexpensive. A smaller panel reduces the cost of applicant's device
25 and therefore is a benefit of applicant's device. The second is that applicant's device is to be hung from a door or from a wall and therefore the usefulness of applicant's device is aided by having a relatively light weight. The size of panel aids in reducing the weight while retaining the benefits for which it is designed.

It is respectfully submitted that the Examiner has mischaracterized the meaning of
30 *In re Aller*. In particular, that case does not state that "it would have been obvious to one having ordinary skill in the art ... to have *any dimensions* that is within a workable range, *in order to optimize the device*." *Aller* states only that when general conditions of a claim are disclosed in the prior art, it is not inventive to find workable ranges. However, such determination is not easily made when the devices themselves serve dissimilar purposes
35 because the questions then become, for what end result is the optimization being effected

5 and what is a workable range? In the present case, there is no optimization for either as
each is optimized for its particular use and function. As explained above, applicant's
device is optimized based on weight and cost variables. The proposed size could not be
an optimization of the Berlin device because such a change to the Berlin device would
cease its functionality of a seat. Unlike *Aller* where the devices were similar, the two
10 devices here do not have interchangeable size variations.

The more pertinent case is *In re Antonie*, 195 USPQ 6. Here the case was decided
in favor of the applicant because the prior art did not contemplate the advantages to the
size variations. Not only does Berlin not discuss size variations, Berlin had no reason to
do so. This is because the panel of Berlin, which the Examiner uses here, is not even part
15 of Berlin's invention. Berlin's invention is a bracket that is attachable to a conventional
child's chair. "My invention relates to a child's chair bracket suspension and more
particularly relates to a bracket for suspending the usual auxiliary automobile seat for
children firmly and securely upon the back of a house chair." Column 1, lines 6-10.
Even Berlin's claims do not mention the seat portion 46. How can one optimize that
20 which remains completely unspecified? As in *Antonie*, it cannot and therefore the size
variations are patentably distinct over Berlin. The same holds true for the elongated
member and arms of Berlin.

As to May, simply because hooks, screws, holes, etc., may be found in another
patent, there cannot be a combination of elements based on only their finding in another
25 patent. There must be a motivation to actually combine the devices. There are simply no
connections between a child chair bracket and an instrument carrier, and there is even
less of a connection when the combination is aimed at a tissue paper holder. Absent
applicant's application being used as a template, there is simply no reason to form the
connection. As stated in the previous office action, such a use of hindsight is not
30 permitted under the law.

The Examiner as dismissed claims 18-21 with the statement, "The method claims
being inherent from the structure cited above." This is not the law regarding a method
claim and cannot be supported by the prior art provided by the Examiner. The method
includes the limitation of a box of tissue paper. That element is missing from Berlin and
35 May and therefore a proper 103 rejection cannot be made to that element. Additionally,

5 the "inherent" nature of Berlin is a child seat and May is an instrument holder. There is nothing inherent in either of those devices to point to their use as a tissue paper holding assembly. In fact, neither of those devices would adequately, if at all, be able to hold a tissue box in the method recited by applicant.

For these reasons it is believed that amended claims 1, 15 and 18, and all
10 remaining claims depending therefrom, are in condition for allowance.

The applicant respectfully requests withdrawal of the rejection.

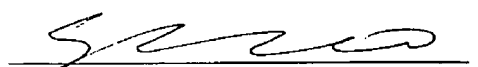
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CONCLUSION

10 In light of the foregoing amendments and remarks, early consideration and
allowance of this application are most courteously solicited.

Respectfully submitted,

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